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Attorney Docket No. SPO-591
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
) Group Art Unit: 1712
MOMODA; KAWASAKI;)
OHTANI) Examiner: R. E. Sellers
)
Serial No. 09/787,395)
)
Filed: March 19, 2001)

For: **METHOD OF PREPARING A CERAMIC ARTIFICIAL
CROWN AND A PREPARATION KIT USED THEREFOR**

TRANSMITTAL LETTER

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

Submitted herewith for filing in the U.S. Patent and
Trademark Office is the following:

- (1) Transmittal Letter; and
- (2) Response to Restriction Requirement.

Respectfully submitted,

SHERMAN AND SHALLOWAY

Handwritten signature of Roger C. Hahn

Attorney for Applicants
Roger C. Hahn
Reg. No. 46,376

SHERMAN AND SHALLOWAY
413 N. Washington Street
Alexandria, Virginia 22314
703-549-2282



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For: **METHOD OF PREPARING A CERAMIC ARTIFICIAL CROWN AND A PREPARATION KIT USED THEREFOR**

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

This is in response to the Official Action bearing a mail date of September 15, 2004. The one-month shortened statutory period for response is set to expire on October 15, 2004. Accordingly, this response is timely filed.

In view of the following remarks, Applicants respectfully request the Examiner to withdraw the pending restriction requirement.

SUMMARY OF RESTRICTION REQUIREMENT
AND SPECIES ELECTION

The Restriction Requirement states as follows:

Group I (claims 1-15 and 19-27) drawn to an uncured composition comprising A) a monomer whose homopolymer has a L-scale Rockwell hardness of not greater than 40, B) a monomer whose homopolymer has a L-scale Rockwell hardness of not less than 60, C) a bifunctional monomer with a L-scale Rockwell hardness of not less than 60, and D) a photochromic compound.

Group II (claims 16-17 and 28-31) drawn to a cured product obtained by curing the composition of Group I.

Group III (claim 18) drawn to a photochromic cured product obtained by curing the composition of Group I coated on a lens.

Momoda et al. Patent No. 6,194,511 (col. 3, lines 31-64) discloses an uncured composition containing a sulfur-containing (meth)acrylate of general formula (1) (col. 3, lines 4-16, conforming to claimed bifunctional monomer C) according to page 22, line 27 to page 23, line 3 of the specification), an epoxy-containing (meth)acrylate such as *glycidyl acrylate* (col. 8, line 29, within the ambit of claimed low hardness monomer A;I as described on page 14, line 25), a (meth)acrylate monomer such as *trimethylolpropane trimethacrylate* (col. 7, line 35, embraced by claimed high hardness monomer B) as set forth on page 18, line 7 and shown in Table 1 on page 51 I TMP-r, page 44, lines 24-26), and a *chromene* photchromic compound possessing thei general formula of claim 3 (col.12, lines 10-35).

4. Japanese Patent No.10-338869 espouses an uncured formulation prepared from *trimethylolpropane trimethacrylate* (translation, page 5, paragraph 24, line 2 and page 15, paragraph 94, line 2, "TMPT"),

glycidyl, ethyl or butyl acrylate (page 6, paragraph 31, lines 5 and 10, encompassed by low hardness monomer A) as disclosed on page 14, lines 23-25), *divinylbenzene* (page 7, paragraph 32, line 5, a species of bifunctional monomer C) as acknowledged on page 19, line 15), and a *chromene* photochromic compound having the general formula of claim 3 (page 8, paragraphs 35 and 36).

5. The claimed composition does not make a contribution over the prior art, thereby validating a holding of lack of unity.

The application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

PROVISIONAL ELECTION

Applicants elect with traverse Group I (claims 1-15 and 19-27) drawn to a method of preparing a crown as stated in the Restriction Requirement. With respect to the species restriction, Applicants elect the following compounds:

(A) The low hardness monomers:

polyethylene glycol dimethacrylate (average molecular weight of 550) shown as 9G in the Examples;

(B) The high hardness monomers:

Trimethylolpropane trimethacrylate shown as "TMPT" in the Examples;

(C) The bifunctional monomers:

Triethylene glycol dimethacrylate shown as "3G" in the Examples;

(D) The photochromic compound:

The compound shown as "chromene 2" in the Example on page 46 of the specification.

In the event the Restriction is not overcome, Applicants preserve the right to pursue the subject matter of the unelected claims in later applications.

TRAVERSAL

Applicants respectfully traverse the Examiner's Restriction Requirement as to Groups I-III and elect Group I. The species election is listed *supra* for the low hardness, the high hardness and bifunctional monomers as well as for the photochromic compounds.

Turning to the rule, the Federal Circuit held that the touchstone for requiring restriction is determining whether two or more independent and distinct inventions are claimed within the same application. MPEP §806. Restriction should never be required where the claims of an application define the same

essential characteristics of a single disclosed embodiment of the invention. MPEP §806.03.

Furthermore, it has been held that in a national stage application filed under 35 U.S.C. § 371, the Examiner **must** apply PCT Rule 13.2 in determining unity of invention. Caterpillar Tractor Co. v. Comm. Of Patents and Trademark, 650 F.Supp. 218; 231 U.S.P.Q. 590 (E.D.Va.1986); See MPEP §1850.

PCT Rule 13.2 in turn states that unity of invention exists where the claimed inventions share one or more special technical features. Id. The term special technical feature is defined as those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art. Id.

In the present application, the Restriction alleges that Groups I-III do not relate to a single general inventive concept because they lack the same or corresponding technical feature. The Restriction then continues somewhat perplexingly that the special technical feature is an uncured composition comprising A) a monomer whose homopolymer has a L-scale Rockwell hardness of not greater than 40, B) a monomer whose homopolymer has a L-scale Rockwell hardness of not less than 60, C) a bifunctional

monomer with a L-scale Rockwell hardness of not less than 60, and D) a photochromic compound.

However, as can plainly be seen by an examination of the claims, Groups II and III share the same technical feature recited by the Restriction. Groups II and III both recite an uncured composition comprising A) a monomer whose homopolymer has a L-scale Rockwell hardness of not greater than 40, B) a monomer whose homopolymer has a L-scale Rockwell hardness of not less than 60, C) a bifunctional monomer with a L-scale Rockwell hardness of not less than 60, and D) a photochromic compound.

Although Group II is drawn to a cured product of the composition of Group I and Group III is drawn to a cured product coated on a lens, both Groups II and III contain the same technical feature of an uncured composition comprising A) a monomer whose homopolymer has a L-scale Rockwell hardness of not greater than 40, B) a monomer whose homopolymer has a L-scale Rockwell hardness of not less than 60, C) a bifunctional monomer with a L-scale Rockwell hardness of not less than 60, and D) a photochromic compound.

In particular, claim 16 (Group II) recites: A photochromic cured product obtained by curing the curable composition of claim 1. Claim 18 (Group III) recites: A photochromic cured

product of claim 15, which is a coated layer on the lens. Claim 15 recites: a curable composition according to claim 1.

Clearly, both Groups II and III contain the same technical feature recited in Group I (claim 1). Applicants remind the Examiner that PCT Rule 13.2 must be applied in determining unity of invention because the captioned application is a national stage application filed under 35 U.S.C. § 371. Since Groups II and III both contain the same technical feature, Applicants are entitled to examination of all Groups I-III.

Momoda et al. is not prior art.

Regarding the use of U.S. Patent No. 6,194,511 ("Momoda et al.") and Japanese Patent No. 10-338869 ("Hara et al.") to make the assertion that the claimed invention does not make a contribution over the prior art, Applicants note that Momoda et al. is not prior art against the captioned application.

In particular, the Restriction alleges that the special technical feature of Groups I-III is an uncured composition comprising A) a monomer whose homopolymer has a L-scale Rockwell hardness of not greater than 40, B) a monomer whose homopolymer has a L-scale Rockwell hardness of not less than 60, C) a bifunctional monomer with a L-scale Rockwell hardness of not

less than 60, and D) a photochromic compound. The Restriction continues that the claimed invention does not make a contribution over the cited references thereby validating a holding of a lack of unity.

However, Momoda et al. is not prior art because the only provision of § 102 that Momoda et al. falls under is § 102(e) wherein Momoda et al. is disqualified as prior art because the captioned application and the reference are commonly assigned to Tokuyama Corp.

Momoda et al. is only a reference under § 102(e) because Momoda et al. issued on February 27, 2001, which is after the International filing date of July 18, 2000, for the captioned application. Moreover, Momoda et al. is disqualified as prior art because Momoda et al. and the captioned application are commonly assigned to Tokuyama Corp.

Although a § 102(e)/§103 obviousness rejection has not technically been made in the outstanding Restriction Requirement, Applicants raise this point in response to the allegation that Momoda et al. shows that the claimed invention does not make a contribution over the prior art. Momoda et al. is not properly cited against the claimed invention and therefore cannot establish the state of the art.

Applicants proffer evidence of common ownership between Momoda et al. and the captioned application, which will be submitted at an appropriate stage during normal prosecution. The submitted arguments is only made to point out that Momoda et al. is not a proper reference in the putative §102(e)/§103 obviousness rejection.

Accordingly, Applicants respectfully request that the Restriction be withdrawn.


CONCLUSION

In view of the foregoing, Applicants respectfully request the Examiner to reconsider and withdraw the restriction requirement and to examine all of the claims pending in this application. If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

Respectfully submitted,

SHERMAN AND SHALLOWAY
P.O. Box 788
Alexandria, Virginia 22313
(703) 549-2282

SHERMAN & SHALLOWAY


Attorney for Applicants
Roger C. Hahn
Reg. No. 46,376